

REMARKS/ARGUMENTS

Status of the Claims

Upon entry of the present amendment, Claims 32-81 are pending. Claims 32-81 are added. Support for new Claims 32-81 is found, for example, on page 6, line 19 through page 7, line 2; on page 7, line 16 through page 8, line 2; and on page 10, lines 19-20.

Applicants respectfully submit that the probes, methods and apparatus of Claims 32-81 are within the scope of originally submitted Claims 1 and 13, because at least a portion of analyte molecules not desorbed by mass spectrometry procedures using the probes set forth in Claims 32-81 remain chemically accessible for subsequent analytical procedures. Applicants submit that no new matter is added by entry of newly added Claims 32-81 and respectfully request entry of the present amendment.

Double Patenting Rejections

The Examiner has rejected Claims 1 and 13 under the judicially created doctrine of obviousness-type double patenting in view of U.S. Patent Nos. 6,020,208; 6,528,320; and 6,734,022. This rejection is respectfully traversed because the claims of the above-cited patents do not teach or suggest the required elements of the present invention of a mass spectrometry probe comprising energy absorbing molecules and an affinity reagent, both immobilized by chemical bonding to the probe sample presenting surface, wherein the energy absorbing molecules and affinity reagent are different. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(b) in view of U.S. Patent Nos. 4,468,468 and 5,045,694

The Examiner has rejected Claims 1 and 13 as being allegedly anticipated by U.S. Patent No. 4,468,468 ("Benninghoven") and U.S. Patent No. 5,045,694 ("Beavis"). This rejection is respectfully traversed to the extent that this rejection applies to newly added Claims 32-81, because neither Benninghoven nor Beavis disclose or suggest a mass spectrometry probe comprising both energy absorbing molecules and an affinity reagent immobilized by

chemical bonding to the probe sample presenting surface, required elements of the probes, methods and apparatus of the present invention. Because neither Benninghoven nor Beavis disclose or suggest each and every element of the claimed invention, they do not anticipate any of claims 32-81. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Information Disclosure Statement

The Examiner has indicated that no copies were supplied of foreign patents or publications or non-patent literature documents listed on the Information Disclosure Statement (IDS) submitted by Applicants on December 5, 2003. However, Applicants expressly indicated in this IDS that the listed references could be found in parent Application No. 09/809,657 (now U.S. Patent No. 6,734,022). Attached to this response is the IDS reference listing submitted by Applicants in Application No. 09/809,657 and signed by the Examiner. On the IDS listing for the '657 Application, the Examiner indicated that copies of GB 22/36184 (reference Y) and Mock, *et al.*, *Rapid Comm Mass Spec* (1992) 6:233-238 (reference AU) were not supplied. Applicants provide herewith copies of both of these references. Non-patent literature documents AQ and AU reference the *same* publication on the IDS listing for the '657 application. Reference AQ, indicated as received by the Examiner, incorrectly cites 1994 as the publication date. Reference AU, indicated as not received by the Examiner, correctly cites 1992 as the publication date (*see*, attached Mock reference). Accordingly, Applicants respectfully submit that the Examiner has access to copies of the references listed on the IDS submitted with the present Application on December 5, 2003 because they were submitted in the parent '657 application. If the Examiner requires additional copies of any the above references, Applicants are happy to provide them.

CONCLUSION

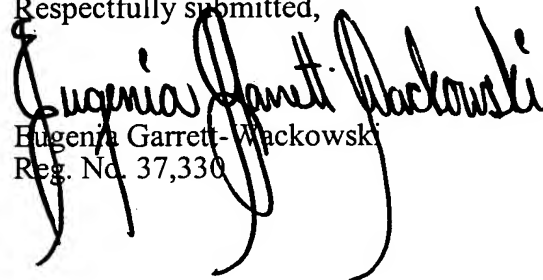
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 10/728,442
Amdt. dated April 27, 2005
Reply to Office Action of October 27, 2004

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,


Eugenia Garrett-Wackowski
Reg. No. 37,330

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
Attachments
EGW:jlw
60493169 v1